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Docket No.: 5244-0130-2

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/575,710
Applicants: Tetsuro MOTOYAMA, et al.
Filing Date: July 25, 2000
For: METHOD AND SYSTEM FOR DIAGNOSING, COLLECTING INFORMATION AND SERVICING A REMOTE SYSTEM
Group Art Unit: 2141
Examiner: NGUYEN, Q.

SIR:

Attached hereto for filing are the following papers:

APPEAL BRIEF

Our credit card payment form in the amount of **$500.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO: 5244-0130-2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:
TETSURO MOTOYAMA, ET AL.	: EXAMINER: NGUYEN, Q..
SERIAL NO: 09/575,710	:
FILED: MARCH 19, 2004	: GROUP ART UNIT: 2141
FOR: METHOD AND SYSTEM FOR DIAGNOSING, COLLECTING INFORMATION AND SERVICING A REMOTE SYSTEM	:

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants appeal the outstanding Final Rejection of April 1, 2005, finally rejecting each of pending claims 1, 3, 4, 6-11, 13, 14, 16-21, 23, 24, and 26-39.

I. REAL PARTY IN INTEREST

The above-noted application is assigned to Ricoh Company, Ltd., which is the real party in interest, having a place of business at Tokyo, Japan.

II. RELATED APPEALS AND INTERFERENCES

Applicants and Applicants' representative are not aware of any related appeals or interferences that will directly effect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1, 3, 4, 6-11, 13, 14, 16-21, 23, 24, and 26-39 are pending in this application and the rejection of each of claims 1, 3, 4, 6-11, 13, 14, 16-21, 23, 24, and 26-39 is being appealed.

Claims 2, 5, 12, 15, 22, and 25 were cancelled without prejudice and Claims 31-39 were added during prosecution of this application.

IV. STATUS OF AMENDMENTS

A Request for Reconsideration was filed subsequent to the Final Rejection dated April 1, 2005. Accordingly, all previously filed Amendments have been considered by the Examiner and are reflected in the attached claims.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The applicants of the present invention recognized that a problem exists in the current art in that until the present invention there was not a method and system for effectively tracking and managing the status of a remotely monitored device.

Accordingly, Claim 1 sets forth a system for tracking at least one of a device state and a device event of a remotely monitored device. The method recited in Claim 1 is generally supported by Figures 1-3B and paragraphs 1 and 28 of the specification.

In particular, Claim 1 recites a receiver configured to receive the at least one of the device state and the device event of the remotely monitored device, which finds supports, e.g., in element 224 of Figure 3A and paragraph 49 of the specification.

Further, Claim 1 recites a digital storage system configured to maintain a history of (1) the at least one of the device state and the device event of the remotely monitored device,

and (2) a service history of the remotely monitored device, which finds supports, e.g., in element 228 in Figure 3A and element 28 in Figure1; and paragraph 49 of the specification.

Further, Claim 1 recites an analyzer configured to analyze the service history and the at least one of the device state and the device event of the remotely monitored device to determine a service request to be performed on the remotely monitored device, which finds supports, e.g., in elements 226, 230, and 232 of Figure 3A; and paragraph 49 of the specification.

Further, Claim 1 recites a service depot comprising a computer configured (1) to receive the service request from the analyzer over a Wide Area Network (WAN), (2) to analyze the service request, and (3) to contact a user of the remotely monitored device regarding the service request, which finds supports, e.g., in element 30 of Figure 3A; and paragraphs 28 and 51 of the specification.

Further, Claim 1 clarifies that the service depot is configured to provide preventive and reparative maintenance to the remotely monitored device, which finds supports, e.g., in paragraph 11 of the specification.

Dependent Claim 3 clarifies that the Wide Area Network comprises the Internet, which finds support, e.g., in element 10 of Figure 3A; and paragraph 5 of the specification.

Dependent Claim 4 clarifies that the system further comprises a transmitter configured to transmit the service history to the service depot, which finds support, e.g., in elements 224 and 232 of Figure 3A; and paragraph 50 of the specification.

Dependent Claim 7 clarifies that the device comprises a business office machine, while Claim 8 clarifies that the business office machine comprises at least one of a copier, a printer, a fax, a scanner, and a thin server. Moreover, Claim 9 states that the remotely monitored device comprises a mobile unit, while Claim 10 states that the mobile unit

comprises at least one of an automobile, a boat, a train, and an airplane. Claims 7-10 find support, e.g., in paragraph 26 of the specification.

Dependent Claim 31 clarifies that the service depot is configured to transmit the service request to an owner of the remotely monitored device as an electronic mail message. Similarly, Claim 34 states that the computer is configured to contact the user of the remotely monitored device through the WAN, while Claim 35 states that the computer is configured to contact the user of the remotely monitored device by telephone or through an electronic mail message. Claims 31, 34, and 35 find support, e.g., in paragraph 28 of the specification.

Independent Claims 11 and 21 recite limitations analogous to the limitations recited in Claim 1 and are supported by the originally filed specification and drawings in a manner analogous to the support for Claim 1 described above. In particular, Claim 11 sets forth a computer program product including a computer storage medium and a computer program code mechanism embedded in the computer storage medium for causing a computer system to track at least one of a device state and a device event of a remotely monitored device, which generally find support in paragraph 80 of the specification. Similarly, Claim 21 is directed to a computer-implemented method and recites steps analogous to the limitations set forth in Claim 1. Finally, the pending claims that depend from independent Claims 11 and 21 find support in a manner analogous to the support set forth above for the claims that depend from Claim 1.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection being appealed are as follows:

(1) whether the combined teachings of U.S. Patent No. 5,887,216 to Motoyama (hereinafter "the '216 patent") and U.S. Patent No. 6,584,454 to Hummel, Jr. et al.

(hereinafter "the '454 patent") render obvious the subject matter of Claims 1, 3-4, 6-8, 11, 13, 14, 16-18, 21, 23, 24, 26-28, and 31-39 under 35 U.S.C. § 103(a); and

(2) whether the teachings of the '216 and '454 patents in view of U.S. Patent No. 6,167,358 to Othmer et al. (hereinafter "the '358 patent") render obvious the subject matter of Claims 9, 10, 19, 20, 29, and 30 under 35 U.S.C. § 103(a).

VII. ARGUMENT

Claims 1, 3, 4, 6-8, 11, 13, 14, 16-18, 21, 23, 24, 26-28, 31-39

Regarding the rejection of Claim 1 under 35 U.S.C. § 103, the Office Action asserts that the '216 patent discloses everything in Claim 1 with the exception of a service depot configured to receive the service request, to analyze the service request, and to contact a user of the remotely monitored device regarding the service request, and relies on the '454 patent to remedy that deficiency.

The '216 patent is directed to a method and system for determining whether problems exist in a business office device by analyzing user settings of the business office device. However, as admitted in the Office Action, the '216 patent fails to disclose a service depot comprising a computer configured to receive a service request from an analyzer over a Wide Area Network and to analyze the service request, as recited in Claim 1. Further, Applicants respectfully submit that the '216 patent fails to disclose *an analyzer configured to analyze the service history and the at least one of the device state and the device event of a remotely monitored device to determine a service request to be performed on the remotely monitored device*, as recited in Claim 1. Rather, as shown in Figure 8, the '216 patent merely discloses communication between a monitoring device and a monitored device in which the monitoring device requests and receives image density information from the monitored device and, based on the received information, requests a change in a parameter in the monitored device.

However, the '216 patent fails to disclose that the monitoring device is configured to analyze the service history of the remotely monitored device. Rather, the '216 patent merely discloses that "[i]n step 410, the monitoring device analyzes the received information (i.e., compares the received information with information looked up in the database) and determines that it is appropriate to change parameters of the monitored device."[1] Applicants respectfully submit that a disclosure of analyzing image density information received from a monitored machine and "information" looked up in a database is not equivalent to a disclosure of analyzing the service history of the machine. In this regard, Applicants note that page 7 of the Advisory Action dated July 6, 2005, states that "Motoyama teaches in step 410 of Fig. 8, the monitoring device analyzes the received information by comparing the received information with values *such as service history, malfunctions, and other special condition events*...."[2] However, as noted above, the '216 patent only states that the received information is compared with "information looked up in the database." The '216 patent discloses several databases, only one of which stores service history data. Thus, to conclude that "information looked up in the database" is a disclosure that service history data is analyzed is pure speculation and is not supported by any evidence of record. Moreover, Figure 9C of the '216 patent is directed to a database storing the history of the machine and includes an ID field, a date/time field, and an information field and is used to describe malfunctions or other special conditions and events within the machine including the date and time at which the event occurred. However, the passage cited in the Office Action does not refer to Figure 9C, but merely refers to "information" from a database. As shown in Figures 10-15, the '216 patent discloses a statistical method of determining whether the default image density setting of the copier needs to be reset, and does not use the service history of a

[1] '216 patent, column 10, lines 13-18. Emphasis added.
[2] Emphasis added.

machine to make the determination. Applicants submit that the '216 patent is silent regarding the use of the service history of the copier to determine a service request.

The '454 patent is directed to a method and system for delivery of protected software applications to remote systems from a central service facility, wherein the delivery is managed based on the community membership of a remote system user. As shown in Figure 1, the '454 patent discloses a central service facility 22, a management station 70, and medical diagnostic systems 12. Applicants note that page 3 of the Office Action asserts that the '454 patent discloses that the central service facility 22 is configured to receive a service request from the management station 70 to analyze the service request, and to contact the user of the remotely monitored device. However, Applicants note that the management station 70 is not an analyzer configured to analyze the service history of a remotely monitored device, but simply forwards service requests generated by users of the diagnostic systems 12. Rather, the '454 patent discloses that the service histories of the machines are stored in database 88, which is associated with the central service facility 22.[3]

Thus, no matter how the teachings of the '216 and '454 patents are combined, the combinations do not teach or suggest an analyzer configured to analyze a service history and at least one of the device state and device event of the remote of a remotely monitored device to determine a service request to be performed on the remotely monitored device, as recited in Claim 1. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 1 (and dependent Claims 3, 4, 6-8 and 31) should be withdrawn.

In the outstanding Office Action, the stated motivation for combining the teachings of the '216 and '454 patents is "because it would allow the service depot efficiently to schedule service engineers to address the service request and provide off- and on-line service to the

[3] See '454 patent, column 6, lines 13-37.

remote device in response to the service request."[4] However, Applicants note that the '454 patent does not disclose that the service facility 22 allows for efficient scheduling of service engineers, only that the service facility 22 has a bank of operator workstations 86. Thus, the Office Action is simply making a conclusive statement regarding the central service station and is not relying on any factual evidence of record as motivation to combine the cited references. Moreover, Applicants submit that there is no technological motivation to combine the teachings of the '216 and '454 patents. In the '454 system, the service requests originate with the users of the diagnostic machines and are sent to the central service facility 22 via the management station 70. In contrast, in the '216 system, the service requests originate with the monitoring device, which communicates directly with the monitored device. Thus, it is unclear how a combined system in which the '454 management station is replaced by the '216 monitoring device would work since the '216 monitoring device is not configured to send out service requests to a service depot or to simply forward service requests generated by a diagnostic machine. Accordingly, for the reasons stated above, Applicants respectfully submit that the Office Action has failed to provide motivation for one of ordinary skill in the art to combine the teachings of the '216 and '454 patents in the manner suggested in the Office Action.

Independent Claims 11 and 21 recite limitations analogous to limitations recited in Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claims 11 and 21 (and all similarly rejected dependent claims) should be withdrawn.

Regarding the rejection of dependent Claims 9, 10, 19, 20, 29, and 30 under 35 U.S.C. § 103, Applicants respectfully submit that the '358 patent fails to remedy the deficiencies of

[4] See page 4 of the Office Action dated April 1, 2005.

the '216 and '454 patents, as discussed above. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and the rejections of dependent Claims 9, 10, 19, 20, 29, and 30 should be withdrawn.

VIII. CONCLUSION

For the foregoing reasons, Applicants respectfully submit that each of claims 1, 3, 4, 6-11, 13, 14, 16-21, 23, 24, and 26-39 patentably distinguishes over the combined teachings of the '216, '454, and '358 patents. Therefore, the outstanding rejections must be REVERSED.

Respectfully submitted,

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CLAIMS APPENDIX

1. (Rejected) A system for tracking at least one of a device state and a device event of a remotely monitored device, comprising:

a receiver configured to receive the at least one of the device state and the device event of the remotely monitored device;

a digital storage system configured to maintain a history of (1) the at least one of the device state and the device event of the remotely monitored device, and (2) a service history of the remotely monitored device;

an analyzer configured to analyze the service history and the at least one of the device state and the device event of the remotely monitored device to determine a service request to be performed on the remotely monitored device; and

a service depot comprising a computer configured (1) to receive the service request from the analyzer over a Wide Area Network (WAN), (2) to analyze the service request, and (3) to contact a user of the remotely monitored device regarding the service request,

wherein the service depot is configured to provide preventive and reparative maintenance to the remotely monitored device.

2. (Canceled)

3. (Rejected) The system as claimed in claim 1, wherein the Wide Area Network comprises the Internet.

4. (Rejected) The system as claimed in claim 1, further comprising a transmitter configured to transmit the service history to the service depot.

5. (Canceled)

6. (Rejected) The system as claimed in claim 1, wherein the receiver comprises a configuration receiver configured to obtain system information from the device over a Wide Area Network.

7. (Rejected) The system as claimed in claim 1, wherein the device comprises a business office machine.

8. (Rejected) The system as claimed in claim 7, wherein the business office machine comprises at least one of a copier, a printer, a fax, a scanner, and a thin server.

9. (Rejected) The system as claimed in claim 1, wherein the remotely monitored device comprises a mobile unit.

10. (Rejected) The system as claimed in claim 9, wherein the mobile unit comprises at least one of an automobile, a boat, a train, and an airplane.

11. (Rejected) A computer program product, comprising: a computer storage medium and a computer program code mechanism embedded in the computer storage medium for causing a computer system to track at least one of a device state and a device event of a remotely monitored device, the computer program code mechanism comprising:

a first computer code device configured to receive the at least one of the device state and the device event of the remotely monitored device;

a second computer code device configured to maintain a history of (1) the at least one of the device state and the device event of the remotely monitored device, and (2) a service history of the remotely monitored device;

a third computer code device configured to analyze the service history and the at least one of the device state and the device event of the remotely monitored device to determine a service request to be performed on the remotely monitored device; and

a fourth computer code device configured to cause a service depot comprising a computer (1) to receive the service request from the third computer code device over a Wide Area Network (WAN), (2) to analyze the service request, and (3) to contact a user of the remotely monitored device regarding the service request,

wherein the service depot is configured to provide preventive and reparative maintenance to the remotely monitored device.

12. (Canceled)

13. (Rejected) The computer program product as claimed in claim 11, wherein the Wide Area Network comprises the Internet.

14. (Rejected) The computer program product as claimed in claim 11, further comprising:

a fifth computer code device configured to transmit the service history to the service depot.

15. (Canceled)

16. (Rejected) The computer program product as claimed in claim 11, wherein the first computer code device comprises a fifth computer code device configured to obtain system information from the device over a Wide Area Network.

17. (Rejected) The computer program product as claimed in claim 11, wherein the device comprises a business office machine.

18. (Rejected) The computer program product as claimed in claim 17, wherein the business office machine comprises at least one of a copier, a printer, a fax, a scanner, and a thin server.

19. (Rejected) The computer program product as claimed in claim 11, wherein the remotely monitored device comprises a mobile unit.

20. (Rejected) The computer program product as claimed in claim 19, wherein the mobile unit comprises at least one of an automobile, a boat, a train and an airplane.

21. (Rejected) A computer-implemented method, comprising:

receiving at least one of a device state and a device event of a remotely monitored device;

maintaining a history of (1) the at least one of the device state and the device event of the remotely monitored device and (2) a service history of the remotely monitored device;

analyzing the service history and the at least one of the device state and the device event of the remotely monitored device to determine a service request to be performed on the remotely monitored device;

receiving, by a service depot comprising a computer, the service request over a Wide Area Network (WAN);

analyzing, by the service depot, the service request; and

contacting a user of the remotely monitored device regarding the service request,

wherein the service depot is configured to provide preventive and reparative maintenance to the remotely monitored device.

22. (Canceled)

23. (Rejected) The computer-implemented method as claimed in claim 21, wherein the Wide Area Network comprises the Internet.

24. (Rejected) The computer-implemented method as claimed in claim 21, further comprising

transmitting the service history to the service depot.

25. (Canceled)

26. (Rejected) The computer-implemented method as claimed in claim 21, wherein the step of receiving the at least one of the device state and the device event comprises:

obtaining system information from the device over a Wide Area Network.

27. (Rejected) The computer-implemented method as claimed in claim 21, wherein the device comprises a business office machine.

28. (Rejected) The computer-implemented method as claimed in claim 27, wherein the business office machine comprises at least one of a copier, a printer, a fax, a scanner, and a thin server.

29. (Rejected) The computer-implemented method as claimed in claim 21, wherein the remotely monitored device comprises a mobile unit.

30. (Rejected) The computer-implemented method as claimed in claim 29, wherein the mobile unit comprises at least one of an automobile, a boat, a train and an airplane.

31. (Rejected) The system of claim 1, wherein the service depot is configured to transmit the service request to an owner of the remotely monitored device as an electronic mail message.

32. (Rejected) The computer program of claim 11, wherein the fourth computer code device is configured to transmit the service request to an owner of the remotely monitored device as an electronic mail message.

33. (Rejected) The computer-implemented method of claim 21, wherein the transmitting step comprises:

transmitting the service request to an owner of the remotely monitored device as an electronic mail message.

34. (Rejected) The system of claim 1, wherein the computer is configured to contact the user of the remotely monitored device through the WAN.

35. (Rejected) The system of claim 1, wherein the computer is configured to contact the user of the remotely monitored device by telephone or through an electronic mail message.

36. (Rejected) The computer program of claim 11, wherein the fourth computer code device is configured to contact the user of the remotely monitored device through the WAN.

37. (Rejected) The computer program of claim 11, wherein the fourth computer code device is configured to contact the user of the remotely monitored device by telephone or through an electronic mail message.

38. (Rejected) The computer-implemented method of claim 21, wherein the contacting step comprises:

contacting the user of the remotely monitored device through the WAN.

39. (Rejected) The computer-implemented method of claim 21, wherein the contacting step comprises:

contacting the user of the remotely monitored device by telephone or through an electronic email message.

EVIDENCE APPENDIX

None

RELATED PROCEEDING APPENDIX

None